



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/699,076 | 10/27/2000 | Nicos A. Petasis | 06666/005002 | 9032 |

7590 10/17/2002

Scott C. Harris
FISH & RICHARDSON P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122

[REDACTED] EXAMINER

BAKER, MAURIE GARCIA

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1639

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DEA/FCE-1994

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 09/699,076 | 10/27/00 | PETASIS et al | 06666-005002 |

| | |
|----------------------------|--------------|
| EXAMINER | |
| Maurie Garcia Baker, Ph.D. | |
| ART UNIT | PAPER NUMBER |
| 1639 | 9 |

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

Please see attached Notice of Non-Responsive Amendment.

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

Notice of Non-Responsive Amendment

1. The Response filed on June 11, 2002 is not fully responsive to the prior Office action because of the following omission(s) or matter(s):

In the Restriction Requirement, applicant was required to elect from three Groups and then further elect a species (Paper No. 4, paragraph 5). Although an election was indicated in the Response filed on June 11, 2002, this election is not responsive because applicant has elected several different core structures of the claimed library. In the last Notice, the examiner clearly stated the following:

Applicant is requested to elect a combinatorial library for examination; the election should result in a core compound that is common to all library members and a specific library, for purposes of search. Due to these problems/omissions, it is not evident exactly which claims should be under examination in the instant case and thus clarification is requested before examination on the merits. When replying to this Notice, it is also requested that applicant provide a listing of all claims readable on the elected species, including any claims subsequently added.

2. Applicant's election first states that "the applicant provisionally elects a combinatorial library of α -amino acids having a core framework of structure 1" and wherein "the carbonyl component (the compound of formula 14) is glyoxylic acid (HCOCOOH)". This would result in the instant R³ group = H and the instant R⁴ group = COOH. However, applicant then goes on to say that claim 38 reads on the elected species. Claim 38 is drawn to a library of " β,γ -unsaturated- α -amino acid derivatives of formula 23". Most importantly, claim 38 depends from claim 37, which defines

compounds of formula 3. Formula 3 (and also formula 23) clearly does not have the instant R⁴ group = COOH. The same is true for claim 39 (which defines another formula, formula 4). However, applicant states that claim 39 reads on their election as well. In an even more confusing manner, applicant states that claim 36 reads on their election too. This claim recites that the claimed library is the result of "transforming one or more of the plurality of compounds of formula 1 to generate the combinatorial library". Thus, applicant has elected *several* different species than the one first elected (formula 1). In fact, it appears as if applicant has tried to elect *all* of formulas 1, 3, 4, 23 and the result of "transforming one or more of the plurality of compounds of formula 1". It is clear from the instant claims that formula 1 is not generic to any of formulas 3, 4, 23 or the result of "transforming one or more of the plurality of compounds of formula 1". Furthermore, only one species should be elected, regardless of any genus that links them, as the species are deemed to be patentably distinct due to their different structures. Thus applicant's current election is deemed to be non-responsive.

3. Since the above-mentioned amendment (Response) appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
October 7, 2002



MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER